

REMARKS

Claims 1-3 are pending. Claims 1-3 have been amended. The support for the amendments can be found at least in page 44, the third paragraph of the specification. No new matter has been introduced.

Applicants thank Examiner Nelson for withdrawing the previous rejection under 35 U.S.C. §112, first paragraph.

Claim Rejections under 35 U.S.C. §103

I. Applicants respectfully traverse the obviousness rejection of claim 1 under 35 U.S.C. §103(a) over Ito et al. (US 6,458,437; “Ito ‘437”), in view of Ito et al. (US 6,451,445; “Ito ‘445”), and further in view of Sakamoto et al. (US 5,061,571).

Claim 1 has been amended to recite a heat-shrinkable polyester film made by a process comprising heat setting the film after the first stage of drawing in a state of tension in the drawing direction at a tensioning ratio of not less than 1% and not more than 6% with respect to the film after the first stage of drawing, and at a temperature that is the same as or about 1 to 5 °C lower than the temperature of the first stage of drawing for not less than 0.5 seconds and not more than 5 seconds. None of the cited references teaches or suggest a heat setting step after the first stage of drawing as specified in currently amended claim 1.

For example, Ito ‘445 fails to teach or suggest heat setting the polyester film after the first stage of drawing, let alone the specific tensioning ratio, temperature, or period of heat setting recited in claim 1. Applicants submit a Declaration under 37 C.F.R. 1.132 to show that a polyester film prepared according to Example 3 of Ito ‘445 did not satisfy requirements (B) and (C) recited in claim 1. As shown in the Declaration, the polyester film obtained in accordance with Example 3 of Ito ‘445 had a heat shrinkage percentage in a maximum shrinkage direction at 70 °C of 27%, measured in a similar manner as described in Ito ‘445, column 6, lines 32-45. This is consistent with the value of the heat shrinkage percentage along the main shrinkage direction of the film of Example 3 (27%) listed in Table I of Ito ‘445, indicating that the film obtained in applicants’ experiment was a reproduction of the film of Example 3 of Ito ‘445. In

addition, the heat shrinkage percentage in a maximum shrinkage direction of the film obtained according to Example 3 of Ito '445 was 61% and ΔX was 52%, measured as described in the present application (see pages 6-7 of the specification; claims 1-3). As such, the polyester film of Example 3 of Ito '445 did not satisfy requirements (B) or (C) of claim 1, which recite that the heat shrinkage percentage in a maximum shrinkage direction of the obtained film at 85 °C is not less than 75% and ΔX is 10% to 20%, respectively. Therefore, the polyester film of Ito '445, prepared without heat setting the film after the first stage of drawing, does not fall within the scope of claim 1, and the claimed invention achieves unexpected results over Ito '437, in view of Ito '445 and further in view of Sakamoto.

It is important that a polyester film is prepared by the method recited in claim 1 so that requirements (B) and (C) in claim 1 can be met. A film that does not satisfy requirement (C) does not have a small rate of change in a bottle diameter, producing insufficient container reinforcing effects. The cited references fail to teach or suggest the claimed heat-shrinkable polyester film at least because the references fail to teach or suggest heat setting the film after the first stage of drawing or a polyester film satisfying requirements (B) or (C), as recited in claim 1.

For at least the foregoing reasons, claim 1 would not have been obvious over Ito '437, in view of Ito '445, and further in view of Sakamoto. Withdrawal of the rejection is respectfully requested.

II. Applicants respectfully traverse the obviousness rejection of claim 2 under 35 U.S.C. §103(a) over Ito '437, in view of Ito '445, in view of Sakamoto, and further in view of Boseki (JP 2002-331581).

Claim 2 has been amended to recite a heat-shrinkable polyester film made by a process comprising heat setting the film after the first stage of drawing in a state of tension in the drawing direction at a tensioning ratio of not less than 1% and not more than 6% with respect to the film after the first stage of drawing, and at a temperature that is the same as or about 1 to 5 °C lower than the temperature of the first stage of drawing for not less than 0.5 seconds and not more than 5 seconds. None of Ito '437, Ito '445, Sakamoto, and Boseki teaches or suggests this limitation. Furthermore, as discussed above, the polyester film of Ito '445 did not satisfy requirements (B) and (C), as recited in claim 2. Therefore, claim 2 would not have been obvious

over Ito '437, in view of Ito '445, in view of Sakamoto, and further in view of Boseki. Withdrawal of the rejection is respectfully requested.

III. Applicants respectfully traverse the obviousness rejection of claim 3 under 35 U.S.C. §103(a) over Ito '437, in view of Ito '445, in view of Sakamoto, and further in view of Hayakawa et al. (WO 02/087853, English equivalent US 2003/0165658).

The deficiency of Ito '437, Ito '445, and Sakamoto is not cured by Hayakawa. For example, Hayakawa fails to disclose or suggest a heat-shrinkable polyester film made by a process comprising heat setting the film with a tension in the drawing direction at a tensioning ratio of not less than 1% and not more than 6% with respect to the film after the first stage of drawing, and at a temperature that is the same or about 1 to 5°C lower than the temperature of the first stage of drawing for not less than 0.5 seconds and not more than 5 seconds, as recited in currently amended claim 3. Therefore, claim 3 would not have been obvious. Withdrawal of the obviousness rejection of claim 3 is respectfully requested.

Double Patenting Rejections

Claim 1 was rejected on the ground of nonstatutory obviousness-type double patenting as being obvious over claim 1 of US 7,279,204 in view of Sakamoto and Ito '445; claim 2 was rejected on the ground of nonstatutory obviousness-type double patenting as being obvious over claim 1 of US 7,279,204 in view of Sakamoto, in view of Boseki and Ito '445; claim 3 was rejected on the ground of nonstatutory obviousness-type double patenting as being obvious over claim 1 of US 7,279,204 in view of Sakamoto, in view of Hayakawa and Ito '445. Without acquiescence with the rejections, applicants will consider submitting a terminal disclaimer when at least some of the claims are held to be otherwise allowable.

CONCLUSION

In light of the above discussion, the Applicant respectfully submits that the present application is in all aspects in allowable condition, and earnestly solicits favorable reconsideration and early issuance of a Notice of Allowance.

If the filing of this response is deemed not timely, Applicants petition for an appropriate extension of time.

The Examiner is invited to contact the undersigned at (202) 220-4420 to discuss any matter concerning this application. The Office is authorized to charge any fees related to this communication to Deposit Account No. 11-0600.

Respectfully submitted,
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Enclosure

Declaration under 37 C.F.R. 1.132